

REMARKS

In response to the Advisory Action mailed November 16, 2004 (Paper No. 20041110), the Assignee submits the above amendments and enclosed remarks. A Request for Continued Examination (RCE) and fee accompany this paper. In the Advisory Action, rejection of claims 1-40 was maintained as described in the prior Office Action mailed May 10, 2004. In the Office Action, claims 1-40 were rejected as obvious in view of various combinations of the following cited art: U.S. Patent Application Publication No. US 2001/0011245 A1 to *Duhon* (hereinafter "*Duhon*"); "New Privista Product Provides Early Warning System to Combat Identity Theft ID Guard to Build Consumer Confidence, Save Companies Lost Revenue," October 23, 2000 (hereinafter "*Privista*"); U.S. Patent Application Publication No. US 2002/0133462 A1 to *Shetyn* (hereinafter "*Shetyn*"); "About ID Guard," January 24, 2001 (hereinafter "*About ID Guard*"); "PrivacyGuard.com," December 11, 2000 (hereinafter "*Privacy Guard.com*"); "Soups Up ID Theft Monitoring Service," January 26, 2001 (hereinafter "*Soups Up ID Theft Monitoring Service*"); CreditCheck Monitoring Service, December 11, 2000 (hereinafter "*Credit Check*"); and U.S. Patent Application Publication No. US2002/0194143 to *Banerjee et al.* (hereinafter "*Banerjee*").

The present response includes amendments to independent claims 1, 5, 12, 19, 22, and 26; amendments to dependent claims 2, 4, and 16; and adds new claims 41-86. Claims 1-86 are now pending in the present application. The present response traverses all of the prior Office Action rejections. The pending claims now include elements that are neither taught nor suggested by the cited art, and the cited art is distinguished for at least the following reasons:

- The claimed invention can “continuously monitor” a credit reporting database rather than “regularly monitor” (on a weekly basis) a credit reporting database as disclosed by *Privista*.

- The claimed invention can report changes in a credit reporting database to a user when the changes occur rather than reporting changes to the user on a “weekly” basis as disclosed by *Privista*.

- The claimed invention can detect a first type of change to a credit reporting database and a second type of change to the credit reporting database, and can notify a user substantially contemporaneously with when the first type of change and with when the second type of change occur.

- The claimed invention can detect an erroneous modification to a credit reporting database and a subsequent correction of the erroneous modification to the credit reporting database, and can notify a user substantially contemporaneously with when the erroneous modification and with when the correction of the erroneous modification occur.

These and other arguments are presented in the remarks below.

I. THE REJECTION OF CLAIMS 1, 3-6, 10-12, 14, AND 18 (OFFICE ACTION, ¶ 5)

The Office Action rejected Claims 1-6, 9-12, 14-16, 18, and 35-37 under 35 U.S.C. § 103(a) as unpatentable over *Duhon* in view of *Privista* and further in view of *Shetyn*. Office Action, pp. 2-8, ¶ 5. The currently amended independent claims 1, 5, 12, 19, 22, and 26 each relate to continuously monitoring a credit reporting database, credit-related data element, or credit file, and then notifying a user when a change or modification occurs. Notification of a user substantially contemporaneously with when a change occurs

in the user's credit file permits the user to take early action for a variety of reasons such as correcting a credit report, or preventing identity theft. See ¶¶ 15-16.

For at least claim 1, the Office Action admits that *Privista* teaches "wherein the monitoring module monitors the modifications to at least one element selected by the user and sending a notification to the user." Office Action, p. 3. *Privista* specifically discloses only "regularly monitoring" a credit database, and sending a "weekly" notice to a user when changes to the database are detected. Assignee believes that only three organizations in the United States, Experian, TransUnion, and Equifax (the Assignee), have direct access to consumer credit reporting data. At the time of publication of the *Privista* reference, *Privista* obtained its credit reporting data directly from Equifax (the Assignee) in a weekly batch format. *Privista* compared the credit reporting data to previously stored data to determine whether any changes to the data had occurred since the prior week. If a change was detected, then *Privista* could report changes in the consumer's credit reporting data directly to the consumer. However, such changes could only be determined by *Privista* on a weekly basis. For example, if credit reporting data was received from Equifax on a Saturday, processed by *Privista* to detect changes on the same Saturday, and a change occurred to the credit reporting data on Sunday; then *Privista* could not detect the change until the following Saturday when credit reporting data was received from Equifax. Therefore, *Privista* could only monitor and report changes to credit reporting data at least as often as every week, but could not "continuously monitor" credit reporting data, or report changes to the credit reporting data substantially contemporaneously when the changes were made.

A *prima facie* rejection of obviousness under 35 U.S.C. §103(a) requires that all claim limitations be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). As shown above, *Privista* does not teach or suggest “continuously monitoring” credit reporting data; therefore, *Privista* does not teach the limitation of claim 1, “wherein the monitoring module continuously monitors the credit reporting database for modifications to at least one element selected by the user.” (underlining supplied). Thus, not all of the elements of claim 1 are disclosed or suggested by the cited references, and the Office Action fails to make a *prima facie* case of obviousness.

The remaining independent claims 5, 12, 19, 22, and 26 have been amended to include the limitation, or variations of the limitation, “continuously monitoring” and also rely on similar arguments for patentability as advanced above.

Moreover, dependent claims 2-4, 6-11, 13-18, 20-21, 23-25, and 27-40 are ultimately dependent from at least one of the above independent claims for which arguments of patentability have already been advanced above.

II. THE REJECTION OF CLAIMS 19, 20, AND 38 (OFFICE ACTION, ¶ 6)

The Office Action rejected claims 19, 20, and 38 under 35 U.S.C. § 103(a) as unpatentable over *Privista* in view of *Duhon* and further in view of *Shetyn*. Office Action, pp. 8-9, ¶ 6. The Office Action fails to make a *prima facie* case of obviousness for rejecting these claims for at least the same reasons advanced above. Therefore these claims should also be patentable over the cited art.

III. THE REJECTION OF CLAIMS 7 AND 13 (OFFICE ACTION, ¶ 7)

The Office Action rejected claims 19, 20, and 38 under 35 U.S.C. § 103(a) as unpatentable over *Duhon* in view of *Privista* in view of *Shetyn* and further in view of *About ID Guard*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

IV. THE REJECTION OF CLAIM 8 (OFFICE ACTION, ¶ 8)

The Office Action rejected claim 8 under 35 U.S.C. § 103(a) as unpatentable over *Duhon* in view of *Privista* in view of *Shetyn* further in view of *About ID Guard* and in further view of *PrivacyGuard.com*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

V. THE REJECTION OF CLAIM 17 (OFFICE ACTION, ¶ 9)

The Office Action rejected claim 17 under 35 U.S.C. § 103(a) as unpatentable over *Duhon* in view of *Privista* in view of *Shetyn* and further in view of *Soups Up ID Theft Monitoring Service*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

VI. THE REJECTION OF CLAIM 21 (OFFICE ACTION, ¶ 10)

The Office Action rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over *Privista* in view of *Duhon* further in view of *Shetyn* and further in view of *PrivacyGuard.com*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

VII. THE REJECTION OF CLAIMS 26-34 (OFFICE ACTION, ¶ 11)

The Office Action rejected claims 26-34 under 35 U.S.C. § 103(a) as unpatentable over *Privista* in view of *Credit Check* and further in view of *Shetyn*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

VIII. THE REJECTION OF CLAIMS 22-24, AND 39 (OFFICE ACTION, ¶ 12)

The Office Action rejected claims 22-24, and 39 under 35 U.S.C. § 103(a) as unpatentable over *Privista* in view of *Duhon* and further in view of *Shetyn*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

IX. THE REJECTION OF CLAIM 25 (OFFICE ACTION, ¶ 13)

The Office Action rejected claim 25 under 35 U.S.C. § 103(a) as unpatentable over *Privista* in view of *About ID Guard* further in view of *Duhon* further in view of *Shetyn* and further in view of *PrivacyGuard.com*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

X. THE REJECTION OF CLAIM 40 (OFFICE ACTION, ¶ 14)

The Office Action rejected claim 40 under 35 U.S.C. § 103(a) as unpatentable over *Privista* in view of *Credit Check* further in view of *Shetyn* further in view of *Banerjee*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

X. AMENDMENTS TO DEPENDENT CLAIMS 2, 4, AND 16

Dependent claims 2, 4, and 16 have been amended in the present response. The amendment to claims 2 and 4 clarifies the limitation “at least one computer program” in accordance with the present amendment to independent claim 1. Furthermore, the amendment to claim 16 changes the prior element “personal digital assistance” to the correctly state the element as a “personal digital assistant.” Arguments for patentability of these dependent claims have been previously presented above.

XI. NEW CLAIMS 41-86

New claims 41-86 clarify that the claimed invention can detect a first type of change/modification to a credit reporting database and a second type of change/modification to a credit reporting database. A user can then be notified of both the first type of change/modification and the second type of change/modification substantially contemporaneously with when the changes/modifications occur. Independent claims 41, 47, 56, 65, 70, and 76 reflect these and similar limitations. Since *Privista* used batch reporting of credit data on a weekly basis, an erroneous change to a credit report occurring in a later part of a first week would be reported to the user at the end of the first week. Any correction to the erroneous change to the credit report occurring in the early part of the following week would not be reported until the end of the second week. Therefore, *Privista* lacks the ability to report both the erroneous change and the correction of the erroneous change to a user at the time the erroneous change and correction of the erroneous change occur.

Furthermore, none of the other cited art teaches or suggests detecting a first type of change/modification to a credit reporting database and a second type of change/modification to a credit reporting database, and notifying a user of both the first type of change/modification and the second type of change/modification substantially contemporaneously with when the changes/modifications occur. Therefore, claims 41-86 should be patentable over all of the cited references, and allowance of these claims is respectfully requested.

CONCLUSION

Claims 1-86 are pending in the application. Independent claims 1, 5, 12, 19, 22, and 26 have been amended; dependent claims 2, 4, and 16 have been amended; and claims 41-86 have been added. Claims 1-86 are now in condition for allowance. The Examiner is invited and encouraged to contact the undersigned attorney of record at (404) 815-6048 if such contact will facilitate a Notice of Allowance for Claims 1-86. If any additional fees are due, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,



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